

REMARKS/ARGUMENTS

At the outset, applicants' attorney Deshmukh takes the opportunity to sincerely thank Examiner Fletcher for graciously agreeing to conduct telephone interview on September 27, 2010. All of the outstanding rejections were reviewed along with the Examiner's comments stated on the continuation sheet attached to the Advisory Action mailed on August 18, 2010. Though no agreement was reached, it is attorney Deshmukh's understanding that the Examiner would like attorney Deshmukh to clearly distinguish the prior art from the pending claims, especially that relating to the protection of EDC layer even in the absence of a conventional primer in the current invention. Attorney Deshmukh also pointed out to the Examiner the graphical renditions that illustrate the various layers in the prior art and the current claims as well as the amendment to the pigment content of the unmodified water-borne basecoat and the thickness of the metal flake pigment that narrows what is now currently claimed. As a result, it is respectfully submitted that the claims, as amended, now fall outside the teachings of the prior art.

Status of the Application and claims

Of claims 1-9 are pending in the application.

Claim 1 is currently amended.

Claims 1-9 were rejected under 35 U.S.C. § 103 (a).

Rejections Under 35 U.S.C. § 103(a)

In regard to paragraph 2 on page 3 of the Office Action, the subject matter of the various claims was commonly owned at the time the inventions were made and there are no obligations under 37 CFR 1.56.

Claims 1-9 were rejected under 35 U.S.C. § 103(a) as being obvious over Schlaak (U.S. Patent No. 5,976,343), *hereinafter* "Schlaak" in view of US patent 6,331,326 to Tsunoda et al. (*hereafter* Tsunoda).

For the record, applicants repeat the remarks provided in their response mailed on February 17, 2010.

The Office Action in paragraph 4 on page 2 alleges that the UV transmission is a physical property of the coating and since the cited art teaches Applicants' coating materials and the method, the coating thereof inherently possesses these properties. The foregoing remarks are respectfully traversed. As a legal matter, it is

applicants' understanding that the doctrine of inherency applies to a single reference and not to a combination of references. M.P.E.P 2112 entitled "Requirements of Rejection Based on Inherency; Burden of Proof" in (III) states that where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/ 103 rejection. In the current instance, the rejection is based not on a single reference but on a combination of references and the currently claimed composition in terms of a function, property or characteristic and the composition of the prior art is not the same. Thus, it is not seen how the Office could conclude that a combination of references (Schlaak in view of Tsunoda) renders the reduction UV transmission to be inherent.

M.P.E.P 2112 further states in part in IV (EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY) that "[a]n invitation to investigate is not an inherent disclosure" where a prior art reference "discloses no more than a broad genus of potential applications of its discoveries." *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1367, 71 USPQ2d 1081, 1091 (Fed. Cir. 2004) (explaining that "[a] prior art reference that discloses a genus still does not inherently disclose all species within that broad category" but must be examined to see if a disclosure of the claimed species has been made or whether the prior art reference merely invites further experimentation to find the species. There is no teaching in either of these references on how the UV transmission can be reduced to prevent damage to the electrocoat layer or how to go about doing it. The mere statement in Schalk that a generic pigment can be included in a coating composition or the disclosure of certain type of aluminum flakes in Tsunoda does not render the currently claimed method of reducing UV transmission to be inherent in the cited references. Thus, applicants respectfully request clarification since the rejection is based on obviousness and not on anticipation.

Applicants contend that even if one were to combine the teachings of Schlaak with those of Tsunoda, one of ordinary skill in the art would not arrive at the present claimed invention. The applicants provide the following pictorial rendition of various

layers in the references as well as claim 1 of the present invention. From the rendition, it would be clear to one of ordinary skill in the art that:

First: In spite of what is alleged at the bottom on page 3, paragraph 3 A and the first line on page 4 of the Office Action, the second and third coating layers of Schlaak are patentably distinct from the first and second layer of the base coat of claim 1 of the present invention. As noted by Schlaak at column 6, lines 44-48 that it is an **essential component** of the invention that the first water-based lacquer used to produce the second coating layer is **characterized by a higher percentage by weight of polyurethane resins as compared with the second water based lacquer used to produce the third coating layer, i.e., both layers must contain the polyurethane resin**. See also claim 1 of Schlaak. By contrast, second layer of the base coat of the present invention **does not contain the admixture component**. Thus, it is not seen why the Office concluded the second and third layer of Schlaak and first and second layer of claim 1 of the present invention are the same.

Tsunoda Reference

Second metallic paint C containing the
metal flakes type 2

Primer A and/or first metallic paint B
containing non-leafing Al flakes type 1

Substrate

Claim 1 of the present invention

Clear Coat

Second layer-Unmodified base coat with
pigment pkg A (No admixture component)

First Layer-Unmodified base coat with
pigment pkg A plus admixture component

EDC Primer

Substrate

Schlaak

Fourth layer of clear lacquer agent

Third coating layer + pigments + polyurethane resin at higher
percentage than in First Layer

Second Coating layer + pigments +
polyurethane resin

First Electrodeposition lacquer layer

Substrate

The process of Tsunoda achieves a coating having plated-metal like appearance and being superior in hiding power for hiding sand scratches. Tsunoda at Col.6, lines 47-61 explains the principle: The first metallic paint containing the thick aluminum flakes provides for the sand scratch hiding power, whereas the second metallic paint containing the thin aluminum flakes provides for the plated metal-like appearance. As shown in the rendition above, Tsunoda disclose the

process where a primer (A), a first metallic paint (B) containing conventional 100-1000 nm thick aluminum flakes and a second metallic paint (C) containing thin metal flakes having thicknesses not greater than 80.0 nm are coated on a substrate. As shown in table above Tsunoda's metallic paints (A) and (B) have **different pigment compositions**, whereas the modified and the unmodified basecoats used in the process of the present invention don't. They **both have the same pigment composition**. Thus, even if one were to combine the teachings of Tsunoda with that of Schlaak, it would result with two coating layers having different coating compositions (Schlaak requires (essential as per column 6, lines 44-38 in Schlaak) polyurethane in both the layers)) and Tsunoda requires, as noted below, two different types of metal flakes. Neither of these elements is present in claim 1 of the present invention. Thus, it is not seen on what basis the Office alleges that the coatings resulting from combining the teachings from Schlaak with Tsunoda would result in lowering the UV transmission. Since, as noted above, there are compositional differences between the prior art combination and the current claims, moreover, absent any teaching or suggestion in either Schlaak or Tsunoda, it will not occur to one of ordinary skill in the art to modify two distinct types of metal flakes required under Tsunoda and modify the coating composition in Schlaak to arrive at the currently claimed invention. Since neither Schlaak nor Tsunoda were directed to solving the problem of reducing the UV transmission it is not seen why one of ordinary skill in the art would arrive at the currently claimed invention over Schlaak in view Tsunoda.

Applicants in the earlier communication had provided extensive evidence as to why the current claims are patentably distinct from Schlak in view of Tsunoda, **especially the showing of the unexpected results provided in the examples in the current specification**. Applicants respectfully submit that the Office in the current Office Action did not provide any rebuttal as to why the pending claims are still considered to be obvious over the combination of Schlaak and Tsunoda. M. P. E. P. 2145 entitled "Consideration of Applicant's Rebuttal Arguments", states that "Consideration of rebuttal evidence and arguments requires Office personnel to weigh the proffered evidence and arguments. Office personnel should avoid giving no weight, except in rare circumstances, citing *In re Alton*, 76 F3d 1168, 1174-75, 37

USPQ2d 1578, 1582-83 (Fed. Cir. 1996). In view of the foregoing, applicants respectfully request the Office to give due consideration to the arguments presented in the applicants' earlier response in addition to the ones provide herein.

The Office Action on page 5, partial paragraph C noted "Consequently, absent **clear and convincing evidence** of unexpected results demonstrating the criticality of the claimed concentration of metal flake" (emphasis added). The foregoing remark is respectfully traversed. Applicants respectfully submit that under M. P. E. P. 2142 entitled "Legal Concept of Prima Facie Obviousness", fourth paragraph, the ultimate determination of patentability is based on the entire record, by a **preponderance of evidence**, with due consideration to the persuasiveness of any arguments and secondary evidence, citing *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). M. P. E. P. 2142 further noted that the legal standard of a "preponderance of evidence" requires that evidence to be more convincing than the evidence which is offered in the opposition to it and with regard to rejections under 35 USC 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e. the teachings establish a *prima facie* case of obviousness) is more probable than not. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself, MPEP 2142, citing *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990).

In view of the foregoing guidance provided in the Manual, applicants respectfully submit that the Office has not met its burden of establishing *prima facie* case of obviousness and due consideration has not been given to the arguments presented by the applicants to rebut the alleged case of obviousness rejection. For the record, applicants also respectfully request the Office to clarify the legal standard of patentability in view of the guidance provided in the Manual as noted above.

However, in order to further the prosecution and place the case in condition for allowance, applicants further distinguish the currently claimed invention from Schlaak/Tsunoda combination. Claim 1 was amended to recite metal flake pigment having a metal thickness of 10 to 80 nm. Support can be found on page 9, line 6 of

the specification. The amount of said metal flake used is now amended to recite 0.1 to 2% weight percent. Support is found on page 9, line 4 of the specification. As a result of the amendment, the type and the amount of said metal flake pigment recited in claim 1 falls outside the range of Tsunoda and there is no teaching or suggestion to one of ordinary skill in the art to arrive at the current amendment in view of Tsunoda or Schlaak.

As explained in Applicants' specification at page 2, lines 7-29, known coating compositions, including those in the primary reference, Schlaak, have a weakness in that

the production of multi-layer coatings in light metallic color shades, in particular silver color shades, is not readily possible. The reason is UV light (UV radiation), as a constituent of natural daylight, passes through the coating layers applied to the EDC [electrodeposition coating] primer to the surface of the EDC primer to a noticeable extent in the absence of a primer surfacer layer and causes degradation of the EDC primer The possible undesired long-term consequences of an inadmissible level of UV light penetration to the EDC layer are chalking of the EDC layer and delamination of the multi-layer coating over the service life of the coated substrates.

UV absorbers are one solution to the problem, but UV absorbers are not very useful in base coat layers and/or clear coat layers (see page 2, line 30 – page 3, line 3).

Applicants have solved a problem of degradation by UV light that has vexed light colored multilayer coatings wherein the base coat layer contains metallic pigments, in particular aluminum pigments. Schlaak does not recognize that such a problem even exists. Therefore, one skilled in the art would not even look to Schlaak to solve this problem let alone modify Schlaak as suggested by the Examiner to include the various parameters of Applicants' amended claims to arrive at the invention as set forth in the amended claims. Without Applicants' specification being used as a roadmap, one could not arrive at the claimed invention which is the obvious impermissible use of hindsight. "[O]nly knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure...is proper" (MPEP 2145 X.A). In the present case, the knowledge was gleaned from Applicants' disclosure and therefore constitutes "impermissible hindsight".

Thus, in order to further distinguish the present invention from Schlaak/Tsunoda combination, claim 1 was amended to recite "special effect multi-layer coatings having problematic color shades". Support can be found on page 2, lines 15-18, and page 4, lines 1-4 of the specification. Neither of the cited references, taken alone or in combination, addresses the problems of harmful UV transmission through special effect coatings having problematic color shades that can then damage the underlying EDC primer.

Summary

In view of the foregoing amendments and remarks, applicants respectfully submit that this application is in condition for allowance. In order to expedite disposition of this case, the Examiner is invited to contact applicants' representative at the telephone number below to resolve any remaining issues. Should there be any additional fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,
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